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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
024,111	03/26/79	Yasuhide Tachi, et al.,	A13132P1

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EXAMINER	
Roberts	
ART UNIT	PAPER NUMBER
125	11

DATE MAILED:

MAILED

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

MAR 10 1980

☐ This application has been examined. ☒ Responsive to communication filed on Nov. 2, 1979 ☒ This action is made final. **GROUP 120**

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited, Form PTO-892.
- ☐ Notice of Informal Patent Drawing, PTO-948.
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ _____

Part II SUMMARY OF ACTION

- ☒ Claim 1 ^{is} ~~are~~ pending in the application.
Of the above, claims _____ are withdrawn from consideration.
- ☐ Claims _____ have been cancelled.
- ☐ Claims _____ are allowed.
- ☒ Claim 1 ^{is} ~~are~~ rejected.
- ☐ Claims _____ are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.
- ☐ The formal drawings filed on _____ are acceptable.
- ☐ The drawing correction request filed on _____ has been ☐ approved. ☐ disapproved.
- ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____
filed on _____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

Claim 1 is the sole claim remaining in the case.

Claim 1 is again rejected under 35 USC 103 as being obvious from the disclosure of Ercoli et al, Elks et al and Shapiro et al, all of record, for the reasons stated in the last Office Action. Applicants' arguments have been considered but are deemed to be of no patentable significance. The test of obviousness is not express suggestion of the claimed invention in any or all of the reference but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them. One skilled in the art, having before him the teachings of the cited references would readily recognize that in general the properties of such a well known anti-inflammatory as hydrocortisone could be materially altered and/or improved by forming various 17; 21 diesters of the same. This fact in itself is sufficient to provide motivation to a skilled chemist to combine the references in the manner done by the Examiner.

In addition, it can not be questioned that esters are ordinarily unpatentable over the alcohols from which they are derived. Ex parte Korten 71 USPQ 173. However, the teachings of the references go far beyond this general decision by establishing the basic reasons for forming esters;

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the specific methods used to form the esters; and specifically setting forth the numerous types of esters that may be formed. The specific ester combination recited in the claim is of no patentable significance insofar as the acylating agents are old and the ester is a result of choices obvious to one of ordinary skill in the art. Hence, since nothing new or unobvious has been shown, the claim fails to define patentably over the present state of the art.

Since an issue has been reached on the merits, this rejection is made FINAL.


A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS LETTER.

Roberts/jlb

A/C 703

557-2575

03/06/80


Elbert L. Roberts
Primary Examiner
Art Unit 125